

## **REMARKS**

### **Claim Rejections 35 U.S.C. § 112, first paragraph**

The Examiner has rejected claims 1-12 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 2-12 are dependent on claim 1. In the opinion of the Examiner, claim 1 contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most connected, to make and/or use the invention.

Applicants have amended claim 1 to comply with the enablement requirement.

In view of the foregoing, Applicants respectfully request the Examiner to withdraw the rejections to claims 1-12 under 35 U.S.C. §112, first paragraph.

### **Claim Rejections 35 U.S.C. § 112, second paragraph**

The Examiner has rejected claim 11 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Applicants have amended claim 11 to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In view of the foregoing, Applicants respectfully request the Examiner to withdraw the rejection to claim 11 under 35 U.S.C. §112, second paragraph.

**Claim Rejections 35 U.S.C. § 103 (a)**

**Claims 1-10 and 12**

The Examiner has rejected claims 1-10 and 12 under 35 U.S.C. §103 (a) as being unpatentable over Casey, Jr. et al. (US 6,042,738).

Applicants respectfully disagree with the Examiner. Applicants have amended claim 1. Support is provided at lines 13-14 on page 12 and lines 23-24 on page 13 of the specification.

Claim 1, as amended, of Applicants' claimed invention claims an apparatus (400) comprising: a holder (420) adapted to mount a substrate (410); a stage (430) adapted to position said holder in a chamber (470); a pumping system (480) adapted to evacuate said chamber; an imaging system (440) adapted to locate an opaque defect (405) in said substrate, said imaging system comprising a first electron column; a gas delivery system (450) adapted to dispense a reactant gas towards said defect; and an electron delivery system (460) adapted to direct electrons towards said opaque defect and induce etching by said reactant gas, said electron delivery system comprising a second electron column. See Figure 4.

In contrast, Casey, Jr. et al. teaches an apparatus with a single column (12). See Figure 1. Thus, Applicants' claimed invention, as claimed in claim 1, would not have been obvious to one of ordinary skill in the art of semiconductors at the time the invention was made.

Applicants have canceled claims 2 and 3 without prejudice. Claims 4-10 and 12 are dependent on claim 1, as amended. Consequently, Applicants' claimed invention, as claimed in claims 4-10 and 12, would also not have been obvious to one of ordinary skill in the art of semiconductors at the time the invention was made.

In view of the foregoing, Applicants respectfully request the Examiner to withdraw the rejections to claims 1, 4-10, and 12 under 35 U.S.C. §103 (a).

### Claim 11

The Examiner has rejected claim 11 under 35 U.S.C. §103 (a) as being unpatentable over Casey, Jr. et al. (US 6,042,738) in view of Katzschner et al. (US 4,987,346).

Applicants respectfully disagree with the Examiner. Applicants have amended claim 11.

Claim 11, as amended, of Applicants' claimed invention claims the apparatus of claim 1 further comprising an acceleration system adapted to provide a low acceleration voltage for the electrons.

Claim 1, as amended, of Applicants' claimed invention claims an apparatus (400) comprising: a holder (420) adapted to mount a substrate (410); a stage (430) adapted to position said holder in a chamber (470); a pumping system adapted to evacuate said chamber; an imaging system (440) adapted to locate an opaque defect (405) in said substrate, said imaging system comprising a first electron column; a gas delivery system (450) adapted to dispense a reactant gas towards said defect; and an electron delivery system (460) adapted to direct electrons towards said opaque defect and induce etching by said reactant gas, said electron delivery system comprising a second electron column. See Figure 4.

In contrast, Casey, Jr. et al. teaches an apparatus with a single column (12). See Figure 1. Thus, combination of the apparatus of Casey, Jr. et al. with the electron beam of Katzschner et al. would still not produce the apparatus claimed in claim 11 of Applicants' claimed invention. Consequently, Applicants' claimed invention, as claimed in claim 11, would not have been obvious to one of ordinary skill in the art of semiconductors at the time the invention was made.

In view of the foregoing, Applicants respectfully request the Examiner to withdraw the rejection to claim 11 under 35 U.S.C. §103 (a).

Conclusion


Applicants believe that all claims pending are now in condition for allowance so such action is earnestly solicited at the earliest possible date.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of this application, the Examiner is invited to contact the undersigned at (408) 720-8300.

Respectfully submitted,

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